



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/501,676

02/22/2005

Terje Skaug

915-001.036

2315

4955 7590 06/17/2009

WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP
BRADFORD GREEN, BUILDING 5
755 MAIN STREET, P O BOX 224
MONROE, CT 06468

EXAMINER

KARIMI, PEGEMAN

ART UNIT

PAPER NUMBER

2629

MAIL DATE

DELIVERY MODE

06/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/501,676 | Applicant(s) SKAUG, TERJE | |
| | Examiner PEGEMAN KARIMI | Art Unit 2629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 03/25/2009 has been entered and considered by the examiner.

Specification

2. The disclosure is objected to because of the following informalities:
 - a. The sentence "This application is a 371 PCT/NO03/00013 01/16/2003" should be inserted after the title on page 1.
 - b. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).

Art Unit: 2629

- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyashita (U.S. Patent No. 6,909,906) in view of Steele (U.S. Patent No. 6,201,534), and further in view of Lee (U.S. Pub. No. 2003/0016417).

As to claim 1, Miyashita teaches an apparatus (100), comprising:

an already existing electronic device having a screen display (the existing electronic device has a display screen 101), and

one or more pointing device components integrated into the already existing electronic device (the pointing device 105 is added to the existing electronic device 100),

wherein said one or more pointing device components are configured to give the already existing electronic device, in addition to its main functions (the already existing electronic devices main function is a mobile telephone, col. 5 lines 2-7),

an auxiliary function as a pointing device (the auxiliary function is the mouse functionality of 105, col. 5, lines 8-11),

Miyashita does not mention the already existing electronic device to act together with an external electronic screen device. Steele teaches the already existing electronic device (400a) to act together with an external electronic screen device (416a), which makes use of the pointing device (108a), (col. 6, lines 48-49) and wherein the external electronic screen device is other than the screen display of the already existing electronic device. (the screen 101 on Miyashita's is different than the screen 416a in Steele because one is attached to the already existing electronic device and the other is not attached to the already existing electronic device and is considered an external display screen). Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the remote control system 400a of Steele to the telephone set main body of Miyashita which will result in a useful and tangible result, wherein the user can use the same device for multiple usage such as a telephone and a cursor positioning device to select an item on the view screen.

Miyashita and Steele do not mention the pointing device being configured to operate independent of a functionality of the existing electronic device.

Lee teaches the pointing device (laser pointer) being configured to operate independent of a functionality of the existing electronic device (mouse, wherein the casing 2 is considered a generic optical mouse [0031], lines 2-3), (the laser guiding device can fit on an end face of the device wherein the ON/OFF is controlled by a push button switch, wherein the functionality of the laser is separate from the functionality of

Art Unit: 2629

the mouse ([0014]). Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the laser guided device separate from the functionality of the mouse of Lee to the apparatus of Miyashita as modified by Steele because to provide a wireless pointing and remote controlling device for briefing, which may cooperate with a conventional laser-guiding device for aiding a briefing operation ([0009]).

As to claim 2, Miyashita does not mention an optical or radio transmission connection with the external electronic device. Steele teaches the already existing electronic device (400a) comprises optical or radio transmission means configured to establish a wireless connection with the external electronic screen device (col. 6, lines 53-56), (the remote control and external screen are connected with an infrared signal).

As to claim 3, Steele the pointing device (400a) components comprise at least one of the following components:

a mechanical or optical reader, a button element and a scroll wheel (108a and 106a).

As to claim 4, Miyashita teaches the pointing device components (109, 107, and 108) are integrated in an auxiliary unit (105), said auxiliary unit is releasably mounted to the already existing electronic device (as can be seen in Fig. 2 the auxiliary unit is releasable from the already existing electronic device 100 by portions 125 and 126, col. 7, lines 5-9) in such a manner that the auxiliary unit can be released and act as a-the

Art Unit: 2629

pointing device separately from the already existing electronic device (as can be seen in Fig. 2 the auxiliary unit 105 is separated from the already existing electronic device 100 and is used as a mouse).

As to claim 5, Steele teaches the auxiliary unit further comprises optical or radio transmission means (infrared connection), said optical or radio transmission means is configured to establish a wireless connection with the external electronic screen device (col. 6, lines 53-56), (the remote control and external screen are connected with an infrared signal).

As to claim 6, Miyashita teaches the auxiliary unit is a battery pack of the already existing electronic device (col. 6, lines 9-12).

As to claim 10, Miyashita teaches the already existing electronic device (100) is one of the following devices: a mobile telephone, a personal data assistant, a digital audio player and a minidisk player (device 100 is a mobile telephone).

As to claim 11, Steele teaches the pointing device (400a) components comprise at least one of the following components:

a mechanical or optical reader, a button element and a scroll wheel (108a and 106a).

As to claim 12, Miyashita teaches the pointing device components (109, 108, and 107) are configured in a body of the already existing electronic device (the components 107-109 are configured in the already existing electronic device 100 via 105) in such a manner that the body is suitable for contact with a user's palm (It can be seen in Fig. 1 that the mobile telephone device is used by a user and requires a user to use the telephone with his/her hand).

As to claim 13, Miyashita teaches the pointing device components (107-109) are configured to perform functionality of a mouse unit (col. 6, lines 8-11).

As to claim 14, Miyashita teaches the pointing device components (107-109) are configured in a body of the already existing electronic device (the components are configured in the already existing electronic device 100 via 105) in such a manner that the body appears to a user like a body of a mouse unit (the body 105 configured in the already existing electronic device 100 is a mouse having left and right buttons 107 and 108 and rotary wheel 109).

Response to Arguments

5. Applicant's arguments with respect to claims 1-6 and 10-14 have been considered but are moot in view of the new ground(s) of rejection.

The newly added prior art of Lee (U.S. Pub. No. 2003/0016417) reads on the newly added limitation(s) of the applicant.

Applicant argues that Miyashita fails to disclose or suggest all of the limitations recited in claim 1, such as “the pointing device is configured to operate independent of a functionality of the existing electronic device”.

Applicant in claim 1 mentions one or more pointing device components integrated into the already existing electronic device. The laser pointer of Lee can be one of the pointing device components that can be integrated into the already existing electronic device 1 (Fig. 1 of Lee)

Lee teaches a laser guided device may be fitted on an end face of the device casing and ON/OFF controlled by a push button switch for projecting laser beam. also if the optical sensor is placed flatly on a pad for operation, this invention may serve for a pure optical mouse [0114]. Therefore the functionality of the laser (pointing device) is different from the functionality of the mouse.

Applicant argues that Steele refers to the remote controller (414a), which is not a cellular phone. Examiner would like to mention that Steele teaches the already existing electronic device (400a) to act together with an external electronic screen device (416a), which makes use of the pointing device (108a) and this functionality of being able to use the cursor pointing device 108a to control a cursor on the monitor as a pointing device. Wherein even with the combination of Miyashita and Steele the functionality of the pointing device of Steele is independent from the functionality of the cellular phone of Miyashita. However, the reference of Lee teaches a one more pointing device component that can be integrated into the device of Miyashita as modified by

Art Unit: 2629

Steele to be used as a pointing device (laser pointer), which functions by a push button switch.

Applicant further argues that Steele does not teach "the functionality of the pointing device is independent of the functionality of the already existing device". The newly added reference of Lee teaches the above limitation.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2629

The following references are similar to the applicant's invention:

KORNMAYER (DE 100 10 087 A 1) teaches the mobile phone has a laser pointer (7) operated by a separate button (8).

SUZUKI (JP 2002-342022A) teaches the mouse has a functional switch that switches between a laser radiation output unit (20a) which is connected to a controller (110) and an infrared communication unit (20b) that transmits control signals to central processing unit of computer based on the operation state of the mouse, detected by an operational detector (120).

Inquiry

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGEMAN KARIMI whose telephone number is (571)270-1712. The examiner can normally be reached on Monday-Thursday 9:00am - 5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pegeman Karimi/
Examiner, Art Unit 2629
June 10, 2009

/Chanh Nguyen/
Supervisory Patent Examiner, Art
Unit 2629